

Appln No. 10/677,810  
Amdt date September 8, 2006  
Reply to Office action of August 9, 2006

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#### REMARKS/ARGUMENTS

Claims 1-24 are pending in the above-referenced application.

Claims 25-30 have been canceled as being drawn to a distinct invention.

This is a response to the restriction requirement dated August 9, 2006 wherein the Examiner has indicated that the application is directed to three distinct inventions. According to 35 U.S.C. §121 of the Patent Law, the Examiner required that Applicant limit the number of inventions disclosed to a single patentable invention. According to the Examiner, there are three distinct inventions identified as follows:

Group I: Claims 1-17 are, "drawn to protective needle clip", classified in class 604, subclasses 110;

Group II: Claims 18-24 are, "drawn to a method for shielding a needle tip", classified in class 604, subclass 500; and

Group III: Claims 25-30 are, "drawn to catheter needle assembly", classified in class 604, Subclass 93.01.

In addition, the Examiner contends that within the group selected, Applicant must elect a single species for prosecution on the merits as these species are also considered patentably distinct. In particular, the Examiner contends that the application contains claims directed to the following patentably distinct species of the claimed invention:

- A. Figures 1-3; and
- B. Figures 4-5.

#### ELECTION

Applicant provisionally elects the invention of Group I, which corresponds to claims 1-17, and Species A, which corresponds to FIGs. 1-3 with traverse. However, as further discussed below, Applicant believes that claims 1-24 should be examined together and that FIGs. 1-3 and 4-5 are of the same species, one set shown in a ready position and another set in an activated position. This is analogous to a car before the ignition is turned on and the same car after the ignition is turned on.

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MPEP §806.05(c) states that:

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process *as claimed* can be practiced by another materially different apparatus or by hand; or (B) that the apparatus *as claimed* can be used to practice another \* materially different process.

Applicant submits that the method of claim 18 cannot be practiced by another materially different apparatus or by hand as it recites the step of moving a hypodermic needle relative to a protective clip and the protective needle clip is the same as or substantially the same as the protective needle clip recited in claim 1.

Nor could the process be practiced by hand since the method recited by claim 18 requires moving a hypodermic needle relative to a protective needle clip and a hand cannot replace a protective needle clip. The hand cannot also be substituted for the step of "allowing at least a portion of the first engaging arm to move radially outwardly away from the needle."

Finally, the apparatus as claimed is designed to block a tip of a needle, which is why it is called a protective needle clip. Hence, the apparatus cannot be practiced for methods unrelated to needle tip protection.

Accordingly, Applicant submits that there is no material difference between the apparatus as claimed and the method as claimed.

Regarding the species election requirement, Applicant submits that the Examiner has erroneously imposed the species election requirement and that a review of the specification for the description of FIGs. 1-3 and FIGs. 4-5 will clearly show that they are one of the same. Accordingly, rescission of the requirement is respectfully requested.

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MPEP §806.05(e) states that:

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process *as claimed* can be practiced by another materially different apparatus or by hand; or (B) that the apparatus *as claimed* can be used to practice another \* materially different process.

Applicant submits that the method of claim 18 cannot be practiced by another materially different apparatus or by hand as it recites the step of moving a hypodermic needle relative to a protective clip and the protective needle clip is the same as or substantially the same as the protective needle clip recited in claim 1.

Nor could the process be practiced by hand since the method recited by claim 18 requires moving a hypodermic needle relative to a protective needle clip and a hand cannot replace a protective needle clip. The hand cannot also be substituted for the step of "allowing at least a portion of the first engaging arm to move radially outwardly away from the needle."

Finally, the apparatus as claimed is designed to block a tip of a needle, which is why it is called a protective needle clip. Hence, the apparatus cannot be practiced for methods unrelated to needle tip protection.

Accordingly, Applicant submits that there is no material difference between the apparatus as claimed and the method as claimed.

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Should the Examiner finds it necessary to speak with Applicant's attorney, he is invited to contact the undersigned at the telephone number identified below.

Respectfully submitted,

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